

REMARKS

Subject to the Examiner's entry of the amendments herein, claims 1-9 and 31-39 are pending in the application. New claims 36-39 have been added. In addition, there may be reasons for patentability of any or all claims that have not been expressed herein. Also, failure to address the specific rejections regarding any claim does not signify agreement with or concession of that rejection.

In the above Office Action the Examiner has rejected claims 1-9 and 31-35 in the manner discussed below.

Claim Rejections – 35 USC §112, 2nd Paragraph

The Examiner has rejected claim 4 under 35 USC §112, 2nd paragraph, because “the phrase ‘in anticipation of’ renders the claim vague and indefinite.” (01/14/09 Office Action, page 4). Applicant respectfully disagrees, because the term “in anticipation of going offline” is supported by the specification. For example, and not by way of limitation, the Detailed Description of the Invention includes the following excerpt:

In the exemplary embodiment, if the server 2402 is going offline (e.g., for maintenance)(Step 2738), the server 2402 may send its inventory of PINs to the hub 2404 (Step 2740). As discussed, while the server 2402 is offline, client terminals are able to contact other servers that are online to receive PINs.

(Application Specification, ¶ 0161). As described in accordance with at least one embodiment, a server can send an inventory of PINs to a hub if it is going offline—that is, a server can send an inventory of PINs to a hub *in anticipation of going offline*. Accordingly, claim 4 is not vague or indefinite for failing to particularly point out and distinctly claim the subject matter regarded as the invention.

The Examiner has also rejected claims 32-34 under 35 USC §112, 2nd paragraph, because “the claims recite ‘said generating ...’” and “there are two requests ‘generated’ in claim 31 that this phrase can be referring to.” (01/14/09 Office Action, page 4). Applicant respectfully notes that claim 31 includes only one “generating” step to which claims 32-33 refer, and that step

includes “generating, at a server, a request for a PIN.” Applicant also respectfully notes that claim 34 does not recite “said generating.”

Claim Rejections – 35 USC §103

Claims 1-5, 7-9 and 31-35 have been rejected under 35 U.S.C. §103 as being unpatentable over the White et al., U.S. Pat. No. 6,169,975 (“White disclosure”), in view of Bullen et al., U.S. Pat. No. 7,197,662 (“Bullen disclosure”). Claim 6 has been rejected in further view of an Official Notice.

White Disclosure

The White disclosure describes “[a] computerized terminal including memory ... adapted to store one or more security numbers, such as PIN numbers, telephone numbers and/or other suitable information corresponding to the information needed by consumers to utilize the service.” (White disclosure, Abstract).

Bullen Disclosure

The Bullen disclosure describes “[a] storage system [with] one or more memory sections, one or more switches, and a management system.” (Bullen disclosure, Abstract).

Differences Between White and Bullen Disclosures and the Presently Claimed Invention

Applicant respectfully submits that the combination of the White and Bullen disclosures fail to teach claims 1-5, 7-9 and 31-35.

With respect to claim 1, the Examiner admits that the White disclosure does not disclose “a hub operatively coupled to each of said servers, wherein said hub is configured to send PINs to each of said plurality of servers for inclusion within said PIN inventories.” (01/14/09 Office Action, page 5). The Examiner, however, asserts that the Bullen disclosure teaches these aspects of claim 1. (01/14/09 Office Action, page 5). Applicant respectfully submits that the Bullen disclosure does not even mention a PIN, let alone a hub that is “configured to send PINs to each

of said plurality of servers for inclusion within said PIN inventories” as claimed. Accordingly, the Examiner has not established a *prima facie* case of obviousness under 35 U.S.C. §103.

With respect to claim 3, the Examiner admitted that the White disclosure does not disclose “a hub.” (01/14/09 Office Action, page 5 (in reference to claim 1 rejection)). The Examiner, however, asserts that the White disclosure teaches a “plurality of servers [that are] configured to send PINs to [a] hub.” (01/14/09 Office Action, page 6). Applicant respectfully submits that the White disclosure, as correctly acknowledged by the Examiner, does not teach a hub, let alone multiple servers that *send PINs to a hub* as claimed. Accordingly, the Examiner has not established a *prima facie* case of obviousness under 35 U.S.C. §103.

With respect to claim 31, the Examiner admits that the White disclosure does not disclose “generating, at a server, a request for a PIN,” “transmitting said request for said PIN from the server to a hub,” and “receiving said PIN at said server from said hub.” (01/14/09 Office Action, page 7). The Examiner, however, asserts that the Bullen disclosure teaches these aspects of claim 31. (01/14/09 Office Action, pages 7-8). Applicant respectfully submits that the Bullen disclosure does not even mention a PIN, let alone the generation of a request for a PIN at a server, the transmission of the request for the PIN from the server to a hub, and the receipt of the PIN at the server from said hub as claimed. Accordingly, the Examiner has not established a *prima facie* case of obviousness under 35 U.S.C. §103.

With respect to claim 34, the Examiner admitted that the White disclosure does not disclose “a hub.” (01/14/09 Office Action, pages 5 and 7 (in reference to claim 1 rejection and claim 31 rejection, respectively)). The Examiner, however, asserts that the White disclosure teaches “a hub request for another PIN ... generated at [a] hub and transmitted to [a] server.” (01/14/09 Office Action, page 8). Applicant respectfully submits that the White disclosure, as correctly acknowledged by the Examiner, does not teach a hub, let alone a *hub that transmits a request for a PIN* to a server as claimed. Accordingly, the Examiner has not established a *prima facie* case of obviousness under 35 U.S.C. §103.

In accordance with the arguments presented above, Applicant respectfully submits that claims 1-5, 7-9 and 31-35 cannot reasonably be said to be taught in the asserted combination of the White and Bullen disclosures, because the failure of that asserted combination to teach or suggest **each and every feature** of a claim is fatal to an obviousness rejection under 35 U.S.C. §

103. In particular, to render claims 1 and 31 and their dependent claims unpatentable, the asserted combination of the White and Bullen disclosures must also teach or suggest each and every claim feature. *See In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974) (to establish *prima facie* obviousness of a claimed invention, all the claim features must be taught or suggested by the prior art). Indeed, as the Board of Patent Appeal and Interferences has recently confirmed, a proper obviousness determination requires that an Examiner make “a searching comparison of the claimed invention – *including all its limitations* – with the teaching of the prior art.” *See In re Wada and Murphy*, Appeal 2007-3733, citing *In re Ochiai*, 71 F.3d 1565, 1572 (Fed. Cir. 1995) (emphasis in original). Further, the necessary presence of all claim features is axiomatic, since the Supreme Court has long held that obviousness is a question of law based on underlying factual inquiries, including ... ascertaining the differences between *the claimed invention* and the prior art. *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966) (emphasis added). Indeed, Applicant submits that this is why Section 904 of the MPEP instructs Examiners to conduct an art search that covers “the invention *as described and claimed*.” (emphasis added). Lastly, Applicant respectfully directs attention to MPEP § 2143, the instructions of which buttress the conclusion that obviousness requires at least a suggestion of all of the features of a claim, since the Supreme Court in *KSR Int’l v. Teleflex Inc.* stated that “there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *KSR Int’l v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007) (*quoting In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)).

In sum, it remains well-settled law that obviousness requires at least a suggestion of all of the features in a claim. *See In re Wada and Murphy*, citing *CFMT, Inc. v. Yieldup Intern. Corp.*, 349 F.3d 1333, 1342 (Fed. Cir. 2003) and *In re Royka*, 490 F.2d 981, 985 (CCPA 1974)).

Accordingly, claims 1-9 and 31-35 are believed to be allowable over the art of record. For at least the reasons presented above, Applicant respectfully requests that the rejection of claims 1-9 and 31-35 be withdrawn and the claims should be allowed.

Amendments to the Claims

Applicant respectfully notes that the amendment to claim 1 is non-substantive and does not necessitate a Final Office Action. This amendment was made in the spirit of cooperation

with the Examiner regarding the “functional recitations using the word and/or phrase[] ... ‘configured to’” cited to by the Examiner. (01/14/09 Office Action, page 10). Applicant appreciates that the Examiner considered “all limitations,” including the limitation regarding the sending of PINs, from the hub, to each of the plurality of servers for inclusion within said PIN inventories.

Double Patenting

In reply to the Examiner’s double patenting rejection, Applicant will file a terminal disclaimer, if appropriate, at such time as one or more claims of the present application are allowed or allowable.

New Claims

Applicant has added new claims 36-39, and requests that they be allowed. Support for new claims 36-39 can be found in Figures 4-5 and 22-28, and associated description of those figures in the Detailed Description of the Invention.

CONCLUSION

It is believed that all of the pending claims have been addressed in this paper. However, failure to address a specific rejection, issue or comment, does not signify agreement with or concession of that rejection, issue or comment. In addition, because the arguments and remarks made above are not intended to be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment.

Applicant respectfully requests consideration of the remarks herein prior to further examination of the above-identified application. The undersigned would of course be available

to discuss the present application with the Examiner if, in the opinion of the Examiner, such a discussion could lead to resolution of any outstanding issues.


The Director is hereby authorized to charge any appropriate fees under 37 C.F.R. §§1.16, 1.17, and 1.21 that may be required by this paper, and to credit any overpayment, to Deposit Account No. 50-1283.

Dated: July 14, 2009

COOLEY GODWARD KRONISH LLP
ATTN: Patent Group
777 6th Street NW, Suite 1100
Washington, DC 20001
Tel: (858) 550-6000
Fax: (202) 842-7899

Respectfully submitted,
COOLEY GODWARD KRONISH LLP

By:



Kyle M. Pendergreass
Reg. No. 57403